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| 10/045,397 | 11/07/2001 | Yutaka Hasegawa | 2552-000004 | 2370 |

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| EXAMINER |
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TRAN, PHILIP B

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| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,397

Applicant(s)

HASEGAWA, YUTAKA

Examiner

Philip B. Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RD

Response to Amendment

Notice to Applicant

1. This communication is in response to the request for reconsideration filed 11 July 2005. Claims 1 and 7-9 have been amended. Therefore, claims 1-9 are pending for further examination.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 and 4-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Rubstein et al (Hereafter, Rubstein), U.S. Pat. Application Pub. No. US 2003/0061566

A1.

Regarding claim 1, Rubstein teaches an apparatus for appending an advertisement to a music card (= animated advertisement is dynamically integrated with executable file for an animated greeting card including media information) [see Abstract], comprising:

a storage device that stores a plurality of image data, a plurality of music data, and a plurality of advertisement data, respectively for creating the music card (=

database that contains the information about purchaser, recipient and the distributed file information including various components of media information) [see Figs. 3-4 & 6 and Paragraphs [0033-0036]];

a receiver that receives a request from a card sender via a network (= purchaser input) [see Fig. 6];

a card creating device that creates, in accordance with the request, the music card by selecting an image data and a music data from the plurality of image data and the plurality of music data stored in said storage device (= creation of the file by integrating message and media into greeting card) [see Figs. 3-4 & 6 and Abstract and Paragraphs [0033-0036]];

an advertisement appending device that appends at least one advertisement data among the plurality of advertisement data stored in said storage device to the music card, if either the selected image data or music data is fee-charged (= personalization by integrating appropriate advertisements into the greeting card file) [see Paragraphs [0038-0040]]; and

a transmitter that transmits the music card free of charge by appending the advertisement data to a card and transmitting said card to a card receiver via the network (= sending the card to the recipient by e-mail message [see Paragraph [0041]] wherein the card file may be distributed for free [see Paragraph [0051]]).

Regarding claim 2, Rubstein further teaches an apparatus for appending an advertisement to a music card according to claim 1, wherein said receiver receives an

advertisement data transmitted from an advertiser, and the advertisement data stored in said storage device are advertisement data transmitted from said advertiser, further comprising an advertiser charging device that charges an advertisement fee to said advertiser if said advertisement appending device appends said advertisement data transmitted from said advertiser (= charging an advertisement fee) [see Paragraphs [0036 & 0040]].

Regarding claim 4, Rubstein further teaches an apparatus for appending an advertisement to a music card according to claim 1, wherein the network is the Internet (= Internet network 14) [see Fig. 1 and Paragraph [0029]].

Regarding claims 5-6, Rubstein further teaches an apparatus for appending an advertisement to a music card according to claim 1, further comprising a notice mail transmitter that transmits a notice mail to the card receiver, the notice mail notifying that the music card was created and saying a method of displaying the music card, wherein the notice mail is an Internet mail and the method of displaying the music card includes a URL of the Internet (= the card is sent to the recipient as an attachment to an email and the recipient can download a copy of the card by invoking the link in the email message) [see paragraph [0041]].

Claims 7-9 are rejected under the same rationale set forth above to claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubstein et al (Hereafter, Rubstein), U.S. Pat. Application Pub. No. US 2003/0061566 A1.

Regarding claim 3, Rubstein does not explicitly teach an apparatus for appending an advertisement to a music card according to claim 1, wherein the music data is a MIDI data. However, MIDI is one of known format in the art for formatting music data. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to format music data in the form of MIDI for efficiently sharing the music file over the Internet as an attachment to an electronic mail as well as playing back the music.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

A. Applicant argued that Rubstein does not teach, disclose or suggest the claimed embodiments of the present invention as recited in independent claim 1, especially amended feature of transmitting the music card free of charge by appending the advertisement data to a card receiver via the network [see Pages 6-7 of the Remarks].

In response to applicant's argument, Rubstein teaches an apparatus for appending an advertisement to a music card such as animated advertisement is dynamically integrated with executable file for an animated greeting card including media information [see Abstract], comprising a storage device that stores a plurality of image data, a plurality of music data, and a plurality of advertisement data, respectively for creating the music card. For example, Rubstein discloses a database that contains the information about purchaser, recipient and the distributed file information including various components of media information [see Figs. 3-4 & 6 and Paragraphs [0033-0036]]. Also, Rubstein further teaches a receiver that receives a request from a card sender via a network. That is, a purchaser input [see Fig. 6].

In addition, Rubstein further teaches a card creating device that creates, in accordance with the request, the music card by selecting an image data and a music data from the plurality of image data and the plurality of music data stored in said storage device. For example, Rubstein discloses creation of the file by integrating message and media into greeting card [see Figs. 3-4 & 6 and Abstract and Paragraphs [0033-0036]]. Moreover, Rubstein further teaches an advertisement appending device that appends at least one advertisement data among the plurality of advertisement data stored in said storage device to the music card, if either the selected image data or music data is fee-charged. For example, Rubstein discloses personalization by integrating appropriate advertisements into the greeting card file [see Paragraphs [0038-0040]]. Last but not least, **Rubstein further teaches a transmitter that transmits the music card free of charge by appending the advertisement data to a**

card and transmitting said card to a card receiver via the network. For example, Rubstein discloses sending the card to the recipient by e-mail message [see Paragraph [0041]] wherein the card file may be distributed for free [see Paragraph [0051]].

In summary, Rubstein teaches or suggests the features recited in claim 1, especially amended feature of transmitting the music card free of charge by appending the advertisement data to a card receiver via the network. The examiner maintains that other dependent claims 2-6 are rejected at least by virtue of their dependency on independent claim 1 and by other reasons set forth above. Claims 7-9 are rejected under the same rationale set forth above to claim 1. Accordingly, claims 1-9 are respectfully rejected as shown above.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip B. Tran
Art Unit 2155
September 29, 2005